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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,916	06/21/2001	Denis O'Leary	72167.000305	6660
21967 7590 09/15/2008 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109				
EXAMINER				
KESACK, DANIEL				
ART UNIT		PAPER NUMBER		
3691				
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09/15/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/886,916

Applicant(s)

O'LEARY ET AL.

Examiner

Daniel Kesack

Art Unit

3691

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to Applicant's remarks and amendment filed May 12, 2008. The amendment has been entered and the arguments have been fully considered. Claims 1-88 are currently pending. The rejections are as stated below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 43, 61, and 75 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As cited in the previous Office Action, it is not clear what is meant by account information. In clarifying the rejection, as requested by Applicant, Examiner respectfully points out that Applicant's specification includes various embodiments which have varying and mutually exclusive scopes of what would be the "account information". Paragraph 61 discloses that payment communications can identify the Web Broker enhanced Wallet user's name. Paragraph 76 discloses that the user can specify whether or not an account number and a name is included with the credits, and alternatively, that information is communicated completely anonymously, with the

recipient having no way to determine where the credit has come from. Paragraph 77 discloses that the user can include partial or complete identification of itself. Therefore, when the claim limitation includes "without account information" it is not clear what limitation has been placed on the information sent. In one embodiment, account information seems to be information related to the user's bank account, and is therefore only bank account numbers, PINs, credit card numbers, and the like. In this case, the information transmitted could include the payor's name and phone number, and could be considered being sent "without account information". However, if account information is considered any information that is related to an account, the payor's name may be inclusive, and the limitation would require that no identifying information whatsoever be transmitted. Reading the claims in light of the specification, one of ordinary skill in the art would not be able to determine the scope of "without account information". For the purposes of applying prior art, Examiner will give the phrase "transmitted over a network without account information" its broadest reasonable interpretation in light of the specification, to mean that the information is transmitted without a customer's account number or credit card number, or similar secretive personal financial information.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-12, 14, 16, 19-21, 23, 24, 26, 27, 29-45, 47-59, 61-86, and 88 remain rejected under 35 U.S.C. 102(e) as being anticipated by Levchin et al., U.S. Patent No. 7,089,208, as cited in the previous office action.

Claims 61, 75, Levchin discloses a system and method for electronically exchanging value among distributed users, comprising:

a payee directory (figure 1, #102 and column 5 lines 5-16), the directory containing at least one identification of the payee (user identifiers) and a correspondence between the at least one identification and the payee account at the payee institution (column 8 lines 35-41, and column 9 lines 4-8);

a first software component coupled to the payee directory, the first software component accepting the at least one identification and an amount of the payment from the payor (column 6 lines 36-41, and column 9 lines 4-8), the first software component generating a payment instruction identifying the payee institution, the payee account,

and an amount of the payment, the first software component further communicating the payment authorization to the payment institution (column 5 line 55 - column 6 line 3);

a second software component at the payor institution coupled to the first software component and coupled to the EFT network, the second software component receiving the payment instruction and transmitting from the payor institution to the payee institution through the EFT network an EFT credit message representing a credit in the amount of the payment (column 9 lines 4-19), the EFT credit message amounting to a pushing of funds from the payor to the payee, wherein in such a pushing of funds a payee account number of the another customer, the payee, is transmitted over the network without account information of the first customer, the payor (column 6 lines 39-41), and wherein the account information includes an expiration date of account (the information may include only the value and the identifier).

Examiner notes the newly added claim language recites an alternative list in combination with a negative limitation. The claim recites that the information *not* sent is at least one of... Therefore, the prior art teaching that at least one of those elements is not sent meets the claimed limitation.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 13, 17, 18, 28, and 46 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Levchin, as cited in the previous office action.

8. Claims 60, 74, and 87 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Levchin, as applied above, and further in view of Magness, U.S. Patent No. 6,769,605, as cited in the previous office action.

9. Claims 15, 22, and 25 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Levchin, as applied above, and further in view of Drummond et al., U.S. Patent No. 7,080,036, as cited in the previous office action.

Response to Arguments

10. Applicant's arguments filed May 12, 2008 have been fully considered but they are not persuasive.

Examiner is of the opinion that the reference of record, as cited above, teaches the claimed "pushing of funds", as broadly interpreted in light of Applicant's

specification. While Examiner was aware of much discussion of "pushing of funds", Examiner was unable to find a clear definition which distinguished pushing of funds from the teachings of the prior art, in spite of Applicant's arguments that the prior art of record does not teach "pushing of funds". Therefore, Examiner was asserting that no discussion or explanation of "pushing of funds" found in the specification made the distinction, which Applicant was arguing, clear. Examiner respectfully appreciates that Applicant has provided evidence of where in the specification "pushing of funds" is clearly disclosed. However, Examiner respectfully disagrees that these portions of the specification distinguish the claimed "pushing of funds" from what is being taught in the prior art.

In light of the entire specification, the limitations described in many of the paragraphs concern specific limitations present in only specific embodiment of the "pushing" and it would therefore not be proper to read these limitations into the claimed "pushing of funds". Considering the entire specification, Examiner is of the opinion that the following paragraphs cited by Applicant in the arguments filed May 12, 2008 characterize "pushing of funds" in the following ways:

paragraph 26: merchant does not receive consumer's account number, credit is transferred between accounts, payor does not provide sensitive information (taught by Levchin, as cited above);

paragraph 50: provides only that conventional models "pull" a payment from the account, while the present invention "pushes" EFT credit to recipient account (Examiner

considers the sending of the credit by the payor, as described above, to accomplish this);

paragraph 61: payor initiates, credit is sent using a recipient ID (taught by Levchin, as cited above);

paragraphs 91-92: describes that the payment is initiated by the payor, not "pulled" by the payee, no sensitive information of the payor is exposed, no pre-existing relationship necessary (taught by Levchin, as cited above);

paragraphs 119-123: capable of requesting a payment and sending a request to anyone with an email address, regardless of if the person is registered with the system (taught by Levchin, as cited above);

Examiner submits that the other provided paragraphs either generally repeat the phrase "pushing of funds" without providing more detail as to what it entails, or describe limitations of specific embodiments which can not be considered inherent in the phrase "pushing of funds" because such limitations are not present in every embodiment of the invention.

Furthermore, nothing in the claims further narrows the phrase. Applicant is directed to the claim language of the independent claims, where it is described as wherein in such a pushing, information associated with the payee is transmitted without the information of the payor. This is precisely what is being taught in the cited portions of Levchin.

Applicant's other arguments amount to a general allegation that Levchin is not teaching pushing of funds, without specifically pointing out the difference between a

pushing of funds, and what is being taught in Levchin. Applicant's arguments at page 24:

"Specifically, while Levchin simply describes a payor 'initiating' the transfer of funds, as is acknowledged in the Office Action, such 'initiating' cannot be fairly asserted to teach the claimed 'pushing' of funds. The Office Action references Levchin's teachings in column 9, lines 4-19. However, such disclosure merely describes that the payor may initiate the transfer. Levchin does not describe the 'pushing' of funds with the account number of the payee, but without the account information of the payor, as recited in claim 1. Applicant submits that the claimed invention reflects a particular interrelationship between the customer interface, i.e., what the customer can effect, vis-a-vis the particular manner in which funds are transferred to the another customer's electronic payment account, i.e., via pushing of the funds. Levchin fails to teach or suggest such particular interrelationship"

It is not clear what limitations the reflected "interrelationship" place on the act of pushing funds. Furthermore, nothing in this argument describes a limitation or feature that is accomplished in the act of pushing funds that is not accomplished by the cited teachings of Levchin.

Furthermore, Applicant argues that the applied art is almost perfectly contrary to the claimed features and fails to teach transmitting information without the account information of the payor (page 25). Examiner respectfully disagrees, given the cited portions of Levchin, in which only an identifier and a value amount is needed (column 9 lines 4-10). Examiner argues that the "identity certificate" which is provided as proof that Levchin is in "complete contrast to the claimed invention" is never sent over the network with the transaction. The identity certificates (column 6 lines 29-45) are provided as a security measure in order to verify the identity of someone using the system. While these certificates are used to create the transaction certificates, it is the

transaction certificates that are used to affect the transfer of funds. Furthermore, Levchin specifically recites that the transaction certificates includes the value being exchanged, and an identifier (column 6 lines 39-40), which is the exact limitation Applicant has claimed. No where does Levchin teach the identity certificate, or the sensitive information encompassed within the identity certificate being transferred along with the funds being sent to the recipient.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Kesack whose telephone number is (571)272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted,

Daniel Kesack
September 10, 2008
/D. K./
Examiner, Art Unit 3691

/Hani M. Kazimi/

Application/Control Number: 09/886,916

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Primary Examiner, Art Unit 3691